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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,910	09/09/2003	Kenichi Chiba	EISN-018CPRCE	5169
959 7590 07/29/2010 LAHIVE & COCKFIELD, LLP FLOOR 30, SUITE 3000 ONE POST OFFICE SQUARE BOSTON, MA 02109				
EXAMINER OH, TAYLOR V				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
07/20/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/657,910

Applicant(s)

CHIBA ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 46-50 and 52-54 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 115-118 is/are allowed.
- 6) ☒ Claim(s) 1, 14, 16-20, 75, 88, 90-94, 108, 110, 124 and 126 is/are rejected.
- 7) ☒ Claim(s) See Continuation Sheet is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-8,10-14,16-20,23,27-31,33,46-50,52-54,62,63,65-76,78-82,84-88,90-95 and 97-126.

Continuation of Disposition of Claims: Claims objected to are 2,4-8,10-13,23,27-31,33,62,63,65-74,76,78-82,84-87,95,97-107,109,111-114,119-123 and 125.

Final Rejection

The Status of Claims

Claims 1-2, 4-8,10-14, 16-20,23,27-31,33,46-50,52-54,62-63,65-76,78-82,84-88,90-95,97-126 are pending.

Claims 1,14, 16-20, 75,88,90-94,108,110,124, and 126 are rejected.

Claims 2,4-8,10-13,23,27-31,33,62-63,65-74,76,78-82,84-87, 95,97-107,109,111-114,119-123, and 125 are objected.

Claims 46-50,52-54 are withdrawn from consideration.

Claims 115-118 are allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 1,14, 16-20, 75,88,90-94,110,124, and 126 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification of the claims.

I. Applicants' argument filed 5/10/10 have been fully considered but they are not persuasive.

However, in spite of the revised claims, there are some new issues to be resolved in the followings:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,14, 16-20, 75,88,90-94,110,124, and 126 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1,14, 75, 88,110, the chemical names "2,2,2-trichloroethoxycarbonyl" for "Troc" and "Bn" for "benzyl", and "PMB(MPM)" for "para-methoxybenzyl", and "3,4-ClBn" for "3,4-dichlorobenzyl" are recited.

These phrases have not been described in the original specification (see pages 21-22, paragraph#0089 and pages 64-65, paragraph# 0180). Therefore, the addition of the new phrases the chemical names "2,2,2-trichloroethoxycarbonyl" for "Troc" and "Bn" for "benzyl", and "PMB(MPM)" for "para-methoxybenzyl", and "3,4-ClBn" for "3,4-dichlorobenzyl" "to the claims does not provide antecedent basis for the proposed

changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a literal supporting description that would be support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

Applicants' Argument

2. Applicants argue the following issues:

a.

"Troc" has been replaced with the term "2,2,2-trichloroethoxycarbonyl". Support for this amendment is found in the published application at paragraph [0180], wherein the text 'Protective Groups in Organic Synthesis' Third Ed. Greene, T. W. and Wuts, P. G., Eds., John Wiley & Sons, New York: 1999, is incorporated by reference. The term "Troc" is defined in this text as "2,2,2-trichloroethoxycarbonyl." The appropriate section of the reference text is attached

b. to this response as Appendix A.

Claim 110 was rejected for recitation of the terms "Bn", "PMB (MPM)" and "3,4-CIBn". The Examiner stated that the terms were vague and indefinite. Applicants respectfully disagree. The meanings of the terms "Bn", "PMB (MPM)" and "3,4-CIBn" are well known to those of ordinary skill in the art, and the benzyl and 3,4-dichlorobenzyl compounds are exemplified in the published application at page 47 and 49, respectively. However, as discussed with the Examiner, and *solely for the purpose of expedited prosecution*, Applicants have amended the claims to replace the terms "Bn", "PMB (MPM)" and "3,4-CIBn" with the terms "benzyl", "para-methoxybenzyl" and "3,4-dichlorobenzyl", respectively. Support for these amendments is found in the published application at paragraph [0180], wherein the text 'Protective Groups in Organic Synthesis' Third Ed. Greene, T. W. and Wuts, P. G., Eds., John Wiley & Sons, New York: 1999, is incorporated by reference. In this text, the term "Bn" is defined as "benzyl", and the terms "PMB and MPM" are defined as "para-methoxybenzyl". The appropriate section of the referenced text is attached to this response as Appendix A.

Applicants' arguments have been noted, but the arguments are not found to be persuasive.

Regarding applicants' argument, the Examiner has noted applicants' argument. However, the display of the appropriate section of the referenced text as Appendix A is sufficient to overcome the 112 second paragraph rejection; replacing their abbreviations to their corresponding chemical names are unnecessary since it may provoke the 112 first paragraph rejection. Applicant is required to cancel the new matter in the reply to this Office Action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taylor Victor Oh/
Primary Examiner, Art Unit 1625
7/18/10

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